A

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,613	11/02/2001	Lawrence P. Shields	74622-020	6203

21890   7590   10/03/2007

PROSKAUER ROSE LLP
PATENT DEPARTMENT
1585 BROADWAY
NEW YORK, NY 10036-8299

EXAMINER
CHANDLER, SARA M

ART UNIT	PAPER NUMBER
3693	

MAIL DATE	DELIVERY MODE
10/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 July 2007*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21 and 35-44* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21 and 35-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for

reconsideration of application 10/003,813 (11/02/01) filed on 07/31/07.

Claim Interpretation

1. In determining patentability of an invention over the prior art, all claim limitations

have been considered and interpreted as broadly as their terms reasonably allow.   See

MPEP § 2111.

> Although the claims are interpreted in light of the specification, limitations from
> the specification are not read into the claims. See *In re Van Geuns*, 988
> F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

> Applicant always has the opportunity to amend the claims during prosecution,
> and broad interpretation by the examiner reduces the possibility that the claim,
> once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415
> F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have

been considered in judging the patentability of the claims against the prior art. See

MPEP 2106 II C. The following language is interpreted as not further limiting the scope

of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result

(e.g., "*for*_____"), but the expression does not result in a manipulative

difference in the steps of the claim. Language in a system claim that states only the

intended use or intended result (e.g., "*for*_____"), but does not result in a

structural difference between the claimed invention and the prior art. In other words, if

the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as "*if, may, might, can could*", as

optional language. As matter of linguistic precision, optional claim elements do not

narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as "*wherein, whereby*", that fail to

further define the steps or acts to be performed in method claims or the discrete

physical structure required of system claims.

> USPTO personnel should begin claim analysis by identifying and evaluating each
> claim limitation. For processes, the claim limitations will define steps or acts to
> be performed. For products, the claim limitations will define discrete physical
> structures or materials. Product claims are claims that are directed to either
> machines, manufactures or compositions of matter. See MPEP § 2106 II C.

> The subject matter of a properly construed claim is defined by the terms that limit
> its scope. It is this subject matter that must be examined. As a general matter,
> the grammar and intended meaning of terms used in a claim will dictate whether
> the language limits the claim scope. Language that <u>suggests or makes optional</u>
> but does not require steps to be performed or does not limit a claim to a
> particular structure does not limit the scope of a claim or claim limitation. The
> following are examples of language that may raise a question as to the limiting
> effect of the language in a claim:

> (A) statements of intended use or field of use,
> (B) "adapted to" or "adapted for" clauses,
> (C) "wherein" clauses, or
> (D) "whereby" clauses.

> See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If

applicant expressly states on the record that two or more independent and distinct

inventions are claimed in a single application, the Examiner may require the applicant to

elect an invention to which the claims will be restricted.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it contains legal

phraseology such as comprises and means for. Correction is required. See MPEP

§ 608.01(b).

Claim Objections

Claims 1 and 2 are objected to because of the following informalities: .

"conduct a transaction to conduct the transaction" should be – conduct a transaction. --

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 and 35-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re Claims 1,2 and 21: The claimed invention indicates that the participant information is coming from a nonvolatile database of a third party administration system. The claimed invention also provides that the participant information in the volatile data storage is updated. The two limitations seem to conflict. In other words, when there is an update to the participant information stored in the volatile data storage, information is being transferred to the volatile data storage. The updated information does not seem to be coming from the nonvolatile database of the third party administration system.

Claims 1, 2 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements or steps, such omission amounting to a gap between the elements or steps. See MPEP § 2172.01. Furthermore, Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

There is a need to the volatile data storage to the other claim limitations. I.e., why is it critical and/or distinct that the third party administration system is not a part of the overall system?

The trading system performs transactions without any regard for the employee stock plan. I.e., In the claims as presently drafted, the transactions performed by the

trading system can relate to any transaction. Need to be doing transactions specific to employee stock options.

In regards to the functions and/or steps of the invention. The correlation between the functions and/or steps needs to be clarified. It is unclear why the communication system is tied to the finance system. I.e., is this tied to the updating function? There appears to be a missing step. I.e., How are you linking what happens in the trading system to the updating of the information? Not clear what the financing system does versus the trading system. There is no interface between the trading system and the finance system.

Dependent claims are further rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-20 and 35-44 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Cristofich, US Pat. No. 6,269,346 in view of Garman, US Pat. No.

5,692,233.

Re Claims 1, 1/3, 1/11 - 1/20, 1/35 - 1/44: Cristofich discloses a system

supporting a plurality of different types of employee stock plans comprising:

a computer-implemented finance system that processes a transaction pursuant to a first

one of the employee stock (Cristofich, abstact, col. 1, lines 13-19; col. 1, lines 45+ - col.

2, line 13; col. 2, line 30-44; col. 2, line 55-67; col. 3, lines 18-19; col. 3, lines 30+ - col.

4, line 33; col. 5, lines 37-46; col. 5, lines 58-col. 6, line 3; col. 6, lines 28-43; col. 8,

lines 19-54; col. 8, lines 63+ -col. 9, lines 32; col. 10, lines 21+ - col. 11, line 7; col. 12,

line 25-62), the finance system including:

a volatile data storage ~~for storing~~ that stores participant information pursuant to a data

transfer from a nonvolatile database of a third party administration system, (Cristofich,

abstract, col. 1, lines 45- 65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col.

4, line 10; col. 5, line 37- col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12,

line 13); and

interacting to provide a participant with information regarding requested transactions

and to enable the participant to select a response pertaining to the first employee stock

plan (Cristofich, abstract, col. 1, lines 20-col.2, lines 28; col. 2, lines 40-48; col. 2, lines

55+- col. 3, lines7; col. 3, lines 30-48; col. 4, lines 10-34; col.5, lines 58 – col. 6, line 3;

col. 6, lines 17-26; col. 7, line 60+ - col. 8, line 18; col. 8, lines 38+ - col.46, line 8; col. 9,

lines 20-58; col. 10 lines 1-33; col. 11, lines 8+- col. 12, line 13; col. 12, line 25+- col.

.14, line 5);

a trading system connected to said interface system, that conducts individual participant

transactions on a public exchange, said trading system being responsive to a response

by the participant t˚conduct a transaction to conduct the transaction (Cristofich,

abstract, col. 1, lines 45-65; col. 2, lines 45-48; col. 3, lines 1-7; col. 3, lines 65+- col. 4,

line10; col. 4, lines 22-col. 4, line 33; col. 5, lines 14-17; col. 7, lines 60+ - col. 8, lines

18; col. 10, lines 1+ - col. 14, line 5);

a communication system that connects the participant to the finance system (Cristofich,

abstract, col. 3, lines 49-65; col. 4, lines 10-34; col. 7, lines 53+ - col. 8, lines 18; col. 11,

lines 8+ - col. 12, line 13; col. 12, line 25+ - col. 14, line 5); and

an updating system that updates the participant information in the volatile data storage

according to the transactions made by the participant (Cristofich, abstract, col. 2, lines

41-44; col. 3, lines 30-65; col. 8, lines 19-37; col. 9, lines 59-67; col. 11, lines 8- col. 12,

lines 13; col. 12, lines 63+ - col. 14, line 5).

Cristofich fails to explicitly disclose:

the third party administration system being not a part of said system for

supporting the plurality of different types of employee stock plans; and

an interface system..

Nonfunctional language:

Cristofich is capable of performing the functional requirements of the claimed

invention (.i.e., "a volatile data storage that stores participant information pursuant to a

data transfer from a nonvolatile database of a third party administration system." In

regard to "the third party administration system being not a part of said system for

supporting the plurality of different types of employee stock plans," the language is

nonfunctional. See also discussion supra regarding claim interpretation.

The claimed invention has not demonstrated any distinguishing functionality or

purpose accomplished by making the third party administration system separate from

the system as opposed to being a part of the system. Thus, having the third party

system as separate from the system is interpreted as being merely a rearrangement of

parts. It has been held that rearranging parts of an invention involves only routine skill

in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Garman discloses an interface system (Garman, abstract, Figs. 4a,4b; col. 3,

lines 54+ - col. 4, line 30; col. 6, line 47+ - col. 7, line 16; col. 8, lines 18-38).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the teachings of Cristofich by adopting the teachings of

Garman to provide a system further comprising: a volatile data storage f-that stores

participant information pursuant to a data transfer from a nonvolatile database of a third

party administration system, the third party administration system being not a part of

said system for supporting the plurality of different types of employee stock plans; and

an interface system configured to provide a participant with information regarding

requested transactions and to enable the participant to select a response pertaining to

the first employee stock plan.

One would have been motivated to provide a convenient and easily usable tool

for users to interact with and manipulate the system.

Re Claims 2, 2/3 – 2/20, 2/35 – 2/44: Cristofich system supporting a plurality of

different types 0[f] employee stock plans comprising:

a computer-implemented finance system for processing a transaction pursuant to a

first one of the employee stock plans (Cristofich, abstact, col. 1, lines 13-19; col. 1, lines

45+ - col. 2, line 13; col. 2, line 30-44; col. 2, line 55-67; col. 3, lines 18-19; col. 3, lines

30+ - col. 4, line 33; col. 5, lines 37-46; col. 5, lines 58-col. 6, line 3; col. 6, lines 28-43;

col. 8, lines 19-54; col. 8, lines 63+ -col. 9, lines 32; col. 10, lines 21+ - col. 11, line 7;

col. 12, line 25-62), the finance system including:

a volatile data storage for-storing that stores participant information pursuant to a data

transfer from a nonvolatile database of a third party administration system, (Cristofich,

abstract, col. 1, lines 45- 65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col.

4, line 10; col. 5, line 37- col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12,

line 13); and

interacting to provide a participant with information regarding requested transactions

and to enable the participant to select a response pertaining to the first employee stock

plan (Cristofich, abstract, col. 1, lines 20-col.2, lines 28; col. 2, lines 40-48; col. 2, lines

55+- col. 3, lines7; col. 3, lines 30-48; col. 4, lines 10-34; col.5, lines 58 – col. 6, line 3;

col. 6, lines 17-26; col. 7, line 60+ - col. 8, line 18; col. 8, lines 38+ - col.46, line 8; col. 9,

lines 20-58; col. 10 lines 1-33; col. 11, lines 8+- col. 12, line 13; col. 12, line 25+- col.

14, line 5);

a trading system connected to said interface system, that conducts individual participant

transactions on a public exchange, said trading system being responsive to a response

by the participant to conduct a transaction to conduct the transaction (Cristofich,

abstract, col. 1, lines 45-65; col. 2, lines 45-48; col. 3, lines 1-7; col. 3, lines 65+- col. 4,

line10; col. 4, lines 22-col. 4, line 33; col. 5, lines 14-17; col. 7, lines 60+ - col. 8, lines

18; col. 10, lines 1+ - col. 14, line 5);

a communication system that connects the participant to the finance system (Cristofich,

abstract, col. 3, lines 49-65; col. 4, lines 10-34; col. 7, lines 53+ - col. 8, lines 18; col. 11,

lines 8+ - col. 12, line 13; col. 12, line 25+ - col. 14, line 5); and

an updating system that updates the participant information in the volatile data storage

according to the transactions made by the participant (Cristofich, abstract, col. 2, lines

41-44; col. 3, lines 30-65; col. 8, lines 19-37; col. 9, lines 59-67; col. 11, lines 8- col. 12,

lines 13; col. 12, lines 63+ - col. 14, line 5); and

a reporting system that enables a corporate employee to run a report based on the

participant information (Cristofich, col. 10, lines 1-11; col. 10, lines 60+ -col. 11, lines 45;

col. 12, lines 14-24).

Cristofich fails to explicitly disclose:

the third party administration system being not a part of said system for

supporting the plurality of different types of employee stock plans; and

an interface system..

Nonfunctional language:

Cristofich is capable of performing the functional requirements of the claimed

invention (.i.e., "a volatile data storage that stores participant information pursuant to a

data transfer from a nonvolatile database of a third party administration system." In

regard to "the third party administration system being not a part of said system for

supporting the plurality of different types of employee stock plans," the language is

nonfunctional. See also discussion supra regarding claim interpretation.

The claimed invention has not demonstrated any distinguishing functionality or

purpose accomplished by making the third party administration system separate from

the system as opposed to being a part of the system. Thus, having the third party

system as separate from the system is interpreted as being merely a rearrangement of

parts. It has been held that rearranging parts of an invention involves only routine skill

in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Garman discloses an interface system (Garman, abstract, Figs. 4a,4b; col. 3,

lines 54+ - col. 4, line 30; col. 6, line 47+ - col. 7, line 16; col. 8, lines 18-38).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the teachings of Cristofich by adopting the teachings of

Garman to provide a system further comprising: a volatile data storage f-that stores

participant information pursuant to a data transfer from a nonvolatile database of a third

party administration system, the third party administration system being not a part of

said system for supporting the plurality of different types of employee stock plans; and

an interface system configured to provide a participant with information regarding

requested transactions and to enable the participant to select a response pertaining to

the first employee stock plan.

One would have been motivated to provide a convenient and easily usable tool

for users to interact with and manipulate the system.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Cristofich, US Pat. No. 6,269,346.

Re Claim 21: Cristofich discloses a method for implementing supporting a

plurality of different types of employee stock plans in an overall system in which the

method operates, comprising:

processing a transaction pursuant to a first one of the employee stock plans via a

computer-implemented finance system (Cristofich, abstact, col. 1, lines 13-19; col. 1,

lines 45+ - col. 2, line 13; col. 2, line 30-44; col. 2, line 55-67; col. 3, lines 18-19; col. 3,

lines 30+ - col. 4, line 33; col. 5, lines 37-46; col. 5, lines 58-col. 6, line 3; col. 6, lines

28-43; col. 8, lines 19-54; col. 8, lines 63+ -col. 9, lines 32; col. 10, lines 21+ - col. 11,

line 7; col. 12, line 25-62);

storing participant information in volatile data storage pursuant to a data transfer from a

nonvolatile database of a third party administration system, (Cristofich, abstract, col. 1,

lines 45- 65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col. 4, line 10; col.

5, line 37- col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12, line 13);

making available to a participant information regarding a requested transaction, and

enabling the participant to select a response pertaining to the first employee stock plan;

conducting the participant transaction on a public exchange via a trading system

in response to the selected response (Cristofich, abstract, col. 1, lines 20-col.2, lines 28;

col. 2, lines 40-48; col. 2, lines 55+- col. 3, lines7; col. 3, lines 30-48; col. 4, lines 10-34;

col.5, lines 58 – col. 6, line 3; col. 6, lines 17-26; col. 7, line 60+ - col. 8, line 18; col. 8,

lines 38+ - col.46, line 8; col. 9, lines 20-58; col. 10 lines 1-33; col. 11, lines 8+- col. 12,

line 13; col. 12, line 25+- col. 14, line 5);

updating the participant information in the volatile data storage according to the

transactions made by the participant (Cristofich, abstract, col. 2, lines 41-44; col. 3, lines

30-65; col. 8, lines 19-37; col. 9, lines 59-67; col. 11, lines 8- col. 12, lines 13; col. 12,

lines 63+ - col. 14, line 5); and

enabling a corporate employer to run a report based on the participant information

pursuant to a reporting system (Cristofich, col. 10, lines 1-11; col. 10, lines 60+ -col. 11,

lines 45; col. 12, lines 14-24).

Cristofich fails to explicitly disclose:

the third party administration system being not a part of the overall system

Nonfunctional language:

Cristofich is capable of performing the functional requirements of the claimed

invention (.i.e., "storing participant information in volatile data storage pursuant to a data

transfer from a nonvolatile database of a third party administration system." In regard to

"the third party administration system being not a part of the overall system," the

language is nonfunctional. See also discussion supra regarding claim interpretation.

The claimed invention has not demonstrated any distinguishing functionality or

purpose accomplished by making the third party administration system separate from

the system as opposed to being a part of the system. Thus, having the third party

system as separate from the system is interpreted as being merely a rearrangement of

parts. It has been held that rearranging parts of an invention involves only routine skill

in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the teachings of Cristofich to provide: storing participant

information in volatile data storage pursuant to a data transfer from a nonvolatile

database of a third party administration system, the third party administration system

being not a part of the overall system.

One would have been motivated by efficiency and convenience to be able to

obtain data from various sources.

Broadest Reasonable Interpretation: The following terms have been given their

broadest reasonable interpretation for purposes of the examination of pending claims 1-

21 and 35-44 (See MPEP § 2111 [R-5]):

- Transaction- any agreement, deal or exchange between parties.

- Volatile data storage- is memory that requires power to maintain the stored

  information.

- Non-volatile database- is a collection of information or records that can be

  retained and stored even when not powered via secondary storage, or long-term

  persistent storage means.

- Participant- any person that participates, shares or takes part.

- Third party Administration System- a system capable of the duty or duties of an administrator with respect to a business or operation.

- Communications System- a system capable of providing information transfer between persons and equipment.

- Interface System- is a system capable of providing the point of interaction or communication between a computer system and any other entity, such as a printer or human operator.

- Trading System- a system capable of allowing parties to engage in buying, selling and/or bartering.

- Reporting System- a system capable of providing an account or statement regarding the details of an event, situation or transaction.

- Public Exchange- a place where things, such as securities and commodities, are bought and sold.

- Employee stock plan- any plan related to the rights or privileges held by an employee with respect to stock or ownership shares in a corporation.

Response to Arguments/Remarks

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Cristofich is capable of performing the functional requirements of the claimed invention (.i.e., "a volatile data storage that stores participant information pursuant to a data transfer from a nonvolatile database of a third party administration system." In

regard to "the third party administration system being not a part of said system for supporting the plurality of different types of employee stock plans," the language is nonfunctional. See also discussion supra regarding claim interpretation.

The claimed invention has not demonstrated any distinguishing functionality or purpose accomplished by making the third party administration system separate from the system as opposed to being a part of the system. Thus, having the third party system as separate from the system is interpreted as being merely a rearrangement of parts. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

The following are suggestions that may help advance prosecution:

(1) The third party administration system does not add any functionality to the claims. In other words, there is no recitation of the third party administration system doing anything in the claims.

How does the structure of the system distinguish over the prior art? What does it accomplish that is different? There must be some different functionality because of the third party administration system being apart from the rest of the system. Similarly, in the method how are these differences clearly articulated in the actively recited steps to be performed?

(2) What are the structural components and active steps of the invention? What is their relationship to the other limitations? They can's just be parts that are not working together.

(3) Reconsider language in the claims.

Several claims recite "enable", "enabling" etc. This type of language does not require that something is done. See discussion supra on claim interpretation.

Recite claim limitations positively. E.g., "stores participant information pursuant to a data transfer" could be -- stores participant information transferred --. E.g., "said trading system being responsive to a response" could be -- said trading system being responsive to an input" E.g. "making available to a participant information: could be -- providing participant information. -- E.g., "enabling the participant" could be -- receiving from the participant --.

(4) Review all claims to make sure there are no grammar, 112 problems (e.g., antecedent basis) etc.

(5) Applicant is encouraged to contact the Examiner regarding language in the claims that will help to clarify the invention and advance prosecution.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any
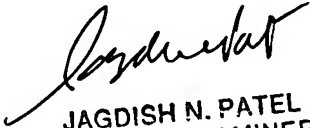
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Sara Chandler whose telephone number is 571-272-

1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Kramer can be reached on 571-272-6783. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC

JAGDISH N. PATEL
PRIMARY EXAMINER